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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,227	08/07/2001	John Blair	7106-001 REG US	2450
7590 01/12/2010 DIANE VAN OS, PATENT ADMINISTRATOR, VISIONEER INC. 8016 SOUTH DEERCREEK CANYON ROAD MORRISON, CO 80465-9530				
EXAMINER				
WORKU, NEGUSSIE				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/924,227

Applicant(s)

BLAIR ET AL.

Examiner

NEGUSSIE WORKU

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 6 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/02)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment and/ or Arguments

1. Applicant's arguments with respect to claims 6, 23-25 have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment. Claims 1, 5, 20-23 have been cancelled and claims 2-4, 6-19, and 23-25 by applicant.

Referring to applicant's amendment and arguments, applicant alleges that the amended subject matter to overcome the rejection. However, examiner respectfully disagree, because the newly amended subject matter to the claims, specifically to claim 6, is un clear and indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention [see 112 second below]. Upon further review, the examiner has incorporated the newly cited prior art to further teach the newly amended limitation as best understood, and has submitted a new ground of rejection necessitated by amendment as further discussed below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6, 23-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, in claim 6, the term "**wherein**" shown in line 10, of claim 6, is deemed to be a term or degree, which has no clearly defined scope within the claim language. Hence, the claim is vague and indefinite, the language of the claim that may raise a question as to the limiting effect of the language in a

claim. The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim: (A) statements of intended use or field of use, (B) **“adapted to” or “adapted for” clauses**, (C) **“wherein” clauses**, or (D) **“whereby” clauses**. This list of examples is not intended to be exhaustive. See also MPEP § 2111.04. USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550- 551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”). Where an explicit definition is provided by the applicant for a term that definition will control interpretation of the term as it is used in the claim. Toro Co. v. White Consolidated Industries Inc., 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a “lexicographic vacuum, but in the context of the specification and drawings.”). Any special meaning assigned to a term “must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.” Multiform

Desiccants Inc. v. Medzam Ltd., 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also MPEP § 2111.01.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6, 23-25, are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata (USP 6,111,659), in view of Reiter (USP 4,604,686).

Referring to claim 6, Murata '659' teaches an image processing method (as shown in fig 1 through 17) in an image acquisition apparatus (image reader 120 of fig 16) connected to at least one USB equipped computer (image reader 120 is connected to computer 121, via connection cable 122 (i.e. USB), which is USB equipped system, as shown in fig 16, discussed in co1.13, lines 45-65) comprising: an image input step for inputting image data into a control circuit within said apparatus (a system shown in fig 16, having an image inputting means i.e. image reader 120 of fig 16, inputting data in to computer 121 i.e. a control circuit [CPU] within the system of fig 16, see co1.13, lines 60-65); a transmittal step for sending said image data from said control circuit through the USB system of said computer (image data from the image reader 120 via transmission cable 122, transferred or exchanged to computer 121 (i.e. a control circuit [CPU] as shown in fig 16 discussed in col.13, lines 45-65); an interface step for said control circuit to receive instructions from, and send data to, control software on said computer upon detection of the insertion of the appropriate media into at least one of a Compact Flash Memory card reader, (the interface step of fig 16, where image reader 120 interface computer 121, which is a control circuit [CPU] via connection cable 122) a Smart Media card reader, a PC or PCMCIA Card reader, a Memory Stick reader, a Multi Media card reader, a Secure Digital card reader, and a IBM Microdrive reader, (the system of fig 16, having at least one a memory card reader 124 of fig 16, where a memory card installed into and

removed from image reader slot 123 of fig 16 to download a read function information to the memory card 124, see co1.13, lines 45-65 and co1.15, lines 50-65 through co1.16, lines 1-20), wherein the inventive software automatically launches a user interface upon insertion and detection thereof and offers one or more user options to process the data without having to press a button on the scanner (since the system of fig 16, has a software, co1.11, lines 48-53, the software execute and generate a scan job command file as shown in fig 20, discussed co1.15, lines 56-66, in which the system [a scanner in connection with computer 121, can be controlled by a software stored in a memory card 124 inserted to scanner to download a read function information to the memory card 124, co1.15, line 5-15, 30-65).

Murata '659' fails to teach or disclose wherein the inventive software automatically launches a user interface (computer program application) upon insertion and detection thereof, with or without the scanner actually scanning an image, and directs the scanned data to a pre-selected application as initially specified by the user wherein said application launches and proceeds with data processing without requiring the user to intercede.

Reiter '686' teaches software automatically launches a user interface (computer program application) upon insertion and detection thereof, with or without the scanner actually scanning an image, and directs the scanned data to a pre-selected application as initially specified by the user wherein said application launches and proceeds with data processing without requiring the user to intercede, (the system of fig 1 and 2, automatically executes the communication of various user terminals using computer program (Pascal) i.e., without requiring the user to intercede the system, see abstract).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the system of Murata by the teaching of Reiter '686' for the purpose controlling the system automatically, so that to increase speed of operation and to reduce human intervention which is time consuming.

Referring to claim 23, Murata '659' teaches the method (as shown in fig 1 through 17), wherein the processing method (as shown in fig 16), is accomplished by insertion of any of said media into one of

two card reader slots contained within a flatbed scanning device (the image processing system of fig 16, comprises a memory card 124, flatbed scanner 120 having a card insertion slot 123 as shown in fig 16) independent of mechanical means or capabilities other than a flatbed scanner connected to a USB equipped computer (image data from the image reader 120 via transmission cable 122, transferred or exchanged to computer 121 (i.e. a control circuit [CPU] as shown in fig 16 discussed in co1.13, lines 45-65).

Murata '659' fails to teach or disclose the image data is processed automatically without requiring user intervention.

Reiter '686' teaches the image data is processed automatically without requiring user intervention, (the system of fig 1 and 2, automatically executes the communication of various user terminals using computer program (Pascal) i.e., without requiring the user to intercede the system, see abstract).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the system of Murata by the teaching of Reiter '686' for the purpose controlling the system automatically, so that to increase speed of operation and to reduce human intervention which is time consuming.

Referring to claim 24, Murata '659' teaches the method (as shown in fig 1 through 17), wherein the processing method may be initiated solely upon insertion of any of said media, wherein the data read from said media is processed without requiring the scanner to scan the image, and whereupon a user interface is automatically launched on said connected computer without further steps by a user (image data from the image reader 120 via transmission cable 122, transferred or exchanged to computer 121 (i.e. a control circuit [CPU] as shown in fig 16 discussed in co1.13, lines 45-65); said user interface providing one or more options for further processing of data obtained from said media (the system of fig 16, has a software, [co1.11, lines 48-53], the software execute and generate a scan job command file [as shown in fig 20, discussed co1.15, lines 56- 66], in which the system [a scanner] in connection with

computer 121, can be controlled by a software stored in a memory card 124 inserted to scanner to down load a read function information to the memory card 124,co1.15, line 5-15, 30-65).

Murata '659' fails to teach or disclose the image data is processed and automatically launched without requiring user intervention.

Reiter '686' teaches the image data is processed automatically without requiring user intervention, (the system of fig 1 and 2, automatically executes the communication of various user terminals using computer program (Pascal) i.e., without requiring the user to intercede the system, see abstract).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the system of Murata by the teaching of Reiter '686' for the purpose controlling the system automatically, so that to increase speed of operation and to reduce human intervention which is time consuming.

Referring to claim 25, Murata teaches the method of wherein the processing method (image processing method as shown in fig 1, 2 and 3) may occur without the scanner having to scan the image, and wherein the user may select one or more programmed buttons on the scanner to instruct the data read from the media to be directed to a computer program for processing, faxing, archiving, emailing or printing (system of fig 1 and 2, operating section 115 of fig 3 of reader section 1 of fig 1, which may be a button to select, paper size or numbers of copy, see fig 5).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEGUSSIE WORKU whose telephone number is (571)272-7472. The examiner can normally be reached on 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Negussie Worku/

Primary Examiner, Art Unit 2625

